

## **REMARKS**

### **Status**

This Amendment is responsive to the Office Action dated February 14, 2005, in which Claims 1-7 were rejected. Claims 1 and 5 are amended in the Application; and Claim 8 is a new claim added to the Application. Claims 1-8 are pending in the Application and are presented for reconsideration and allowance.

### **35 USC 112 -- Claim Rejections**

The Office Action rejected Claim 5 as being indefinite for failing to point out particularly and claim distinctly the subject matter. Applicant has amended Claim 5 as suggested by the Examiner. Applicant has amended the Application to include a new claim to clarify that the first thermal layer can have a thickness ranging. Support for this amendment can be found on Page 7, Lines 23-25 of the Application as filed. Applicant believes no new matter has been added with these amendments. As such, Applicant respectfully requests reconsideration and withdrawal of the rejection to the claims.

### **Double Patenting**

The Office Action provisionally rejected Claims 1-7 as claiming the same invention as that of Claims 1-7 of co-pending Application Number 10/696,117. Applicant expressly abandoned Application Number 10/696,117 on February 23, 2005.

The Office Action rejected Claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 7, and 11-12 of Kerr U.S. Patent Number 6,620,489. Applicant is the owner of the Kerr reference. A terminal disclaimer is included with this Response to overcome the rejection in this Office Action.

### **35 USC 102 -- Claim Rejections**

The Office Action rejected Claims 1-7 under 35 USC 102(f) because the Applicant appears to have invented the claimed subject matter. Since the instant invention is set forth in Claims 1-7 of a commonly assigned

Application Number 10/696,117 and has different inventive entities. Applicant expressly abandoned Application Number 10/696,117 on February 23, 2005.

As expressed earlier in this Response, Applicant expressly abandoned Application Number 10/696,117 on February 23, 2005. As such, Applicants respectfully request reconsideration and withdrawal of the rejection under 102(f) of the Claims 1-7.

### **35 USC 103 -- Claim Rejections**

The Office Action rejected Claims 1-2 and 4-5 USC 103(a) as being unpatentable over *Nordeen* (6,022,440) in view of *Houle* (3,468,450). This rejection is respectfully traversed.

Applicant has amended Claim 1 to clarify the claimed subject matter. Claim 1 has been amended to claim the features of forming the overlay by removing the first support layer, wherein the overlay has a surface charge. Support for this amendment can be found in Paragraph beginning on Page 6, Line 18 of the Specification as filed and in Figure 4. Applicant believes no new matter has been added with this amendment.

Applicant's process creates an overlay having a surface charge for verifying an image on printing plates. Applicant's overlay includes an imaged receiver sheet (140) laminated onto an imageless receiver sheet (160). The imaged receiver sheet (140) includes an image (210), a first thermal print layer (224), and a first support layer (150). The imageless receiver sheet (160) includes a second thermal print layer (228) and a clear second support layer (170). The overlay is formed by removing the first support layer from the laminated imageless receiver sheet (160).

The Applicant's overlay does not use an adhesive, but rather uses a surface energy charge to bind the layers to one another (Paragraphs beginning on Page 4, Line 6 and Page 6, Line 18 of the Specification as filed). Use of a surface charge eliminates the need for additional adhesive layers. Adhesive layers can make the separation of the layers difficult and messy, thereby leading to flaws in the final image. Applicant believes the use of a surface charge to adhere the layers is a novel aspect that allows the overlay to be used for high resolution images.

*Nordeen* provides an image transfer method for transferring images generated by ink-jet inks to a variety of substrates. The *Nordeen* laminate includes an imaged layer with a thermoplastic, which must be an adhesive material that is activated between 40 degrees Celsius and 180 degrees Celsius (Column 6, Lines 41-59). The *Nordeen* laminate also includes a second thermoplastic layer (Column 6, Lines 60-65); and a support or substrate layer. In contrast to the Applicant's overlay, *Nordeen* requires the use of an adhesive thermoplastic layer as a temporary support and the ink receptive layer (Column 6, Lines 41-48). *Nordeen* also requires the use of a solvent to remove the adhesive thermoplastic layer (Column 6, Lines 57-59), wherein the Applicant's overlay does not require the use of a solvent, thereby making the Applicant's overlay cheaper to use and more environmentally friendly.

*Houle* provides a color proofing element that teaches a transparent color proof. *Houle* does not teach the replacing the adhesive of *Nordeen*. *Houle* does not teach using a surface charge to adhere the layer of adhering the layers without an adhesive by using a surface charge.

Claims 2 and 4-5 are dependent on independent Claim 1, and therefore include all the features thereof. For the reasons set forth above with regard to the independent claim, Claims 2 and 4-5 are also believed to be patentable. As such, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims. As such, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims in view of the amendments and expressed remarks.

The Office Action rejected Claims 3 and 6-7 USC 103(a) as being unpatentable over *Nordeen* (6,022,440) in view of *Houle* (3,468,450) in further view of *Silverbrook* (5,984,446). This rejection is respectfully traversed.

Applicant believes the amended claimed subject matter of Claim 1 of the current application has been distinguished from the teachings *Nordeen* in view of *Houle* as noted above. *Silverbrook* teaches a networked high speed color printer. *Silverbrook* teaches forming individual monochrome color separation films at resolutions between 1800 dpi and 3600 dpi. *Silverbrook* does not teach using a surface charge to adhere the layers of an overlay together.

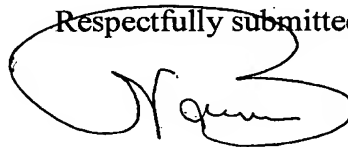
Claims 3 and 6-7 are dependent on independent Claim 1, and therefore include all the features thereof. For the reasons set forth above with regard to the independent claim, Claims 3 and 6-7 are also believed to be patentable. As such, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims. As such, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims in view of the amendments and expressed remarks.

**Summary**

Should the Examiner consider that additional amendments are necessary to place the application in condition for allowance, the favor is requested of a telephone call to the undersigned counsel for the purpose of discussing such amendments.

For the reasons set forth above, it is believed that the application is in condition for allowance. Accordingly, reconsideration and favorable action are respectfully solicited.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.